



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/029,657	12/20/2001	Donna M. Stemmer	014208.1395 (70-00-006)	5061

5073 7590 10/01/2004

BAKER BOTTS L.L.P.
2001 ROSS AVENUE
SUITE 600
DALLAS, TX 75201-2980

EXAMINER

ROBINSON BOYCE, AKIBA K

ART UNIT	PAPER NUMBER
----------	--------------

3623

DATE MAILED: 10/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/029,657

Applicant(s)

STEMMER ET AL.

Examiner

Akiba K Robinson-Boyce

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. Due to communications filed 7/9/04, the following is a final office action. Claims 1-59 are pending in this application and have been rejected. The previous rejection has been withdrawn and the following rejection reflects the claims as amended.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, 11, 14, 16, 31, 32, 43, 45, 3, 4, 12, 13, 15, 17, 18, 19, 21, 33, 34, 41, 42, 44, 46, 47, 48, 50, under 35 U.S.C. 103(a) as being unpatentable over Vig (US 6,038,554), and further in view of Sanders (US 6,411,936).

As per claims 1, 31, Vig discloses:

Identifying one or more intellectual capitals to be measured, wherein the intellectual capital comprises human capital comprising one or more capabilities of one or more individuals associated with the enterprise, (Col. 64, lines 4-5, [represented by the probed entity], w/ col. 84, lines 5-9, [where the probed entity group is shown to pertain to politicians, where the politicians represent the individuals]);

Selecting a set of metrics that are present within the identified intellectual capitals, the set of metrics comprising one or more metrics present within the human capital, one or more metrics within the structural capital, and one or more metrics within the external capital, wherein the set of metrics comprises one or more monetary metrics and one or more non-monetary metrics, (Col. 73, lines 49-54, where metrics are represented by the characteristics, quality, trait, etc., and are relevant to the probed entity group, and where the probed entity group is unlimited as to such entity group's nature or constitution, therefore these metrics are not limited to only human capital, but are unlimited to structural capital and external capital as well, Col. 6, line 65-Col. 7, line 4, where the monetary worth represents the monetary metric, Col. 6, lines 65-67, where non-monetary metrics are represented by the "ride quality" and "reliability").

Assigning values to the set of selected metrics, (Col. 73, line 59-69, represented by the weight of importance).

scaling the set of valued metrics, wherein the scaled non-monetary metrics and monetary metrics are operable to be mathematically associated, (Col. 73, line 65-Col. 74, line 4, represented by rating on a scale)

Quantifying the identified intellectual capitals based on the scaled metrics, (Col. 74, lines 7-13, represented by the analogue value numbers accurately quantifying to represent societal importance).

Vig fails to explicitly disclose an enterprise, which is merely a business organization. However, Vig does disclose a corporation in the Abstract, lines 1-5, which is also a business organization. Therefore Vig indirectly discloses an enterprise.

Vig fails to explicitly disclose that each intellectual capital comprises human capital, structural capital and external capital. However, Vig does disclose intellectual capital through human capital as shown in col. 64, lines 4-5 where the probed entity is disclosed.

However Sanders discloses structural capital comprising experience and expertise of the enterprise embedded in one or more processes, policies, and systems associated with the enterprise, (Col. 20, lines 35-37, [organizational structure]), and external capital comprising a value of one or more business relationships of the enterprise with one or more entities, (Col. 20, line 66-Col. 21, line 2, [externalities]). Sanders discloses structural and external capital in an analogous art with the motivation of showing that an enterprises valuation is not just limited to human capital, but can also be valued according to structural capital and external capital.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to incorporate structural and external capital with the motivation of measuring intellectual capital of an enterprise according to a wide variety of defined capital.

As per claims 2, 16, 32, 45, Vig discloses:

Wherein the human capital is determined based on a plurality of parameters, including one or more of the following:

Training and education of the staff.../wherein the training and education of the staff is determined based on a plurality of metrics, including one or more of the

Art Unit: 3623

following: education level per staff member...(Col. 42, lines 14-20, represented by the education of the doctor).

As per claim 11, Vig discloses:

Further comprising defining the relationship between financial capital and the intellectual capital...(Col. 69, lines 10-14, represented by the communal and particular monetary value).

As per claims 14, 43, Vig discloses:

Wherein the competency information is determined based on a plurality of metrics, including one or more of the following: experience in a competency type; and experience of workforce...(Col. 52, lines 5-10, represented by the experience of a group or part of a group).

As per claims 3, 33, Vig fails to disclose the following, however Sanders discloses:

Wherein the structural capital comprises innovation capital and process capital, (Col. 3, lines 7-23, represented by the gross regarding organizational structures, and Col. 22, lines 22-29, represented by cost reduction through process improvements). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention for the structural capital to comprise innovation capital and process capital with the motivation of gathering all of the pieces necessary to physically and financially complete a structure).

As per claims 4, 19, 34, 48, both Vig and Sanders fail to disclose the following:

Wherein the innovation capital is determined based on a plurality of parameters, including one or more of the following: Internal communications regarding inventions; External communications regarding the inventions; Patent protection; and Delivery to market of products or services embodying the inventions./wherein the patent protection regarding inventions is determined based on a plurality of metrics, including one or more of the following: number of patents owned; value of patents owned; and number of patents proposed:

Official notice is taken that it is old and well known in the art for the innovation capital to be determined based on a plurality of parameters, including Internal communications regarding inventions, external communications regarding the inventions, patent protection, and delivery to market of products or services embodying the inventions. It would have been obvious to one of ordinary skill in the art for the innovation capital to be determined based on a plurality of parameters, including Internal communications regarding inventions, external communications regarding the inventions, patent protection, and delivery to market of products or services embodying the inventions with the motivation of gathering all of the necessary information needed to create and finance the invention.

As per claims 12, 13, 41, 42, Vig fails to disclose the following, however Sanders discloses:

Further comprising a radar diagram, wherein the radar diagram comprises: a plurality of scaled axes, wherein each scaled axis represents one of the metrics present in the intellectual capital; and a point on each axis to represent the quantified

metric/wherein quantifying the identified intellectual capitals based on the scaled metrics comprises determining the total area enclosed in the radar diagram, (Col. 9, lines 10-22 w/ Fig. 4, represented by the multidimensional diagram).

It would have been obvious to one of ordinary skill in the art for a scaled axis to represent one of the metrics present in the intellectual capital with the motivation of allowing the user to clearly visualize the intellectual capital result).

As per claims 15, 17, 44, 46, Vig fails to disclose the following, however Sanders discloses:

Wherein the performance of staff is determined based on a plurality of metrics, including one or more of the following: revenue generating staff/efficiency of organization.../wherein the usage of contractors is determined based on a plurality of metrics, including one or more of the following: revenue generating staff/efficiency of organization, (Col. 11, line 44-Col. 12, line 14, represented by the financial performance of firm).

It would have been obvious to one of ordinary skill in the art for the performance staff to be determined based on metrics including revenue generating staff with the motivation of including a metric that would bring benefit financially.

As per claims 18, 47, Vig fails to disclose the following, however Sanders discloses:

Wherein the internal communications regarding inventions is determined based on a plurality of metrics, including one of more of the following:

Usage of best practices, (Col. 10, lines 3-12, represented by best practices library).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention for the internal communications regarding inventions to be determined based on usage of best practices with the motivation of incorporating tools that would optimize and accurately distribute internal communications.

As per claims 21, 50, Vig fails to disclose the following, however Sanders discloses:

Wherein the delivery to market of products or services embodying the inventions is determined based on a plurality of metrics, including one or more of the following: investment in own research and development, (Col. 9, line 65, represented by research and development expenses).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention for the delivery to market products or services embodying the inventions to be determined based on investment in own research and development with the motivation of determining the cost of finding out necessary information so products can be successfully delivered to the correct locations.

4. Claims 5, 20, 22-27, 35, 49, 51-56, 6, 7, 9, 10, 36, 37, 39, 40, 8, 28, 29, 30, 38, 57, 58, 59, are rejected under 35 U.S.C. 103(a) as being unpatentable over Vig (US 6,038,554), and further in view of Sanders (US 6,411,936) and further in view of Eder (US 6,321,205).

As per claims 5, 35, neither Vig nor Sanders discloses the following, however Eder '205 discloses:

Wherein the process capital is determined based on a plurality of parameters including one or more of the following: business improvement, (Col. 45, lines 26-31, represented by business improvement programs).

It would have been obvious to one of ordinary skill in the art at the time of the invention for process capital to be determined based on business improvement with the motivation of taking the cost of accurately carrying out a process and having an optimized product into consideration.

As per claims 20, 49, neither Vig nor Sanders discloses the following, however Eder '205 discloses:

Wherein the external communications regarding inventions is determined based on a plurality of metrics, including one or more of the following: published internal achievements, (Col. 19, lines 55-61, represented by revenue).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention for the external communications regarding inventions to be determined based on a plurality of metrics including published internal achievements with the motivation of selecting particular achievements to display to the public in order to positively represent the invention.

As per claims 22, 51, both Vig and Sanders fail to disclose the following, however Eder '205 discloses:

Wherein the internal investment is determined based on a plurality of metrics, including one or more of the following:

Investment in internal structures, (Col 38, lines 37-46, represented by the expense component);

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention for the internal investment to be determined based on a plurality of metrics including investment in internal structures with the motivation of incorporating unavoidable costs associated with the development process.

As per claims 23, 52, Vig fails to disclose the following, however Sanders discloses:

Wherein the business improvement is determined based on a plurality of metrics, including one or more of the following: improvement suggestions, (Col. 22, lines 12-24, represented by process improvements).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention for business improvement to be determined based on a plurality of metrics including improvement suggestions presenting ideas that would improve to entire development process.

As per claims 24, 53 Vig fails to disclose the following, however Sanders discloses:

Wherein the collaboration among staff is determined based on a plurality of metrics including one or more of the following: time saved by leveraging, (Col. 3, lines 19-24, represented by knowledge leveraged).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to determine collaboration among staff based on time saved by leveraging with the motivation of delivering continuous optimization through staff for a long period of time.

As per claims 25, 54, both Vig and Sanders fail to disclose the following, however Eder '205 discloses:

Wherein the support tools for the staff is determined based on a plurality of metrics, including one or more of the following: wherein the support tools for the staff is determined based on a plurality of metrics, including one or more of the following: Tool availability for staff...(Col. 2, lines 50-52, represented by tools facilitating the analysis of information).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention for the support tools for the staff to be determined based on tool availability for the staff with the motivation of guaranteeing that proper tools will be available upon request from a staff member.

As per claims 26, 55, Vig discloses:

Wherein the information sharing is determined based on a plurality of metrics, including one or more of the following: information availability for staff, (Col. 3, lines 53-61, represented by available information).

As per claims 27, 56, Vig discloses:

Wherein the capabilities of the customers is determined based on a plurality of metrics, including one or more of the following: delivery speed and quality, (Col. 61, lines 39-42, represented by fast delivery of pizza).

As per claims 6, 36, Vig fails to disclose the following, however Eder '406 discloses:

Wherein the external capital comprises supplier capital, customer capital, partner capital, and image in market, (Table 4 of Col. 10, represented by the Capital value attributed to loyal customers).

It would have been obvious to one of ordinary skill in the art at the time of the invention for the external capital to comprise customer capital with the motivation of including an accurate figure for external capital where customers are included.

As per claims 7, 9, 37, 39, Vig discloses:

Wherein the supplier capital/partner capital is determined based on a plurality of parameters including one or more of the following: customer satisfaction with suppliers/customer satisfaction with a partner, (Col. 30, lines 6-11, represented by passenger satisfaction).

As per claims 10, 40 Vig discloses the following:

Wherein the mage in market is determined based on a plurality of parameters including one or more of the following: image in a community, (Col. 35, [under style section], represented by the category image).

As per claims 8, 38, Vig fails to disclose the following, however Sanders discloses:

Art Unit: 3623

Wherein the customer capital is determined based on a plurality of parameters, including one or more of the following: relationships with the customers, (Col. 22, lines 20-24, represented by customer relationship).

It would have been obvious to one of ordinary skill in the art for the customer capital to be determined based on the relationships with the customers with the motivation of determining which relationships are good for wisely investing in.

As per claims 28, 57, Vig fails to disclose the following, however Sanders discloses:

Wherein the capabilities of the customers is determined based on a plurality of metrics, including one or more of the following: number of organization enhancing customers...(Col. 1, lines 25-31, represented by corporations growing shareholder). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to determine the customer's capabilities based on the number of organization enhancing customers with the motivation of finding a representation of customers dedicated to building the organization he or she is in.

As per claims 29, 58, both Vig and Sanders fail to disclose the following, however Eder '406 discloses:

Wherein the relationships with the customers is determined based on a plurality of metrics, including one or more of the following: longevity of customers, (Col. 37, line 38, represented by customer longevity).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention for relationships with customers to be determined based on

Art Unit: 3623

longevity of customers with the motivation of determining which customers will most likely stay committed to the group.

As per claims 30, 59, Vig discloses:

Wherein the satisfaction of the customers is determined based on a plurality of metrics, including one or more of the following: satisfied customer index, (Col. 54, lines 40-44, represented by customer satisfaction).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention for the satisfaction of the customers to be determined based on a satisfied customer index since this index actually represents and presents data for customers who are pleased.

Response to Arguments

5. Applicant's arguments filed 7/9/04 have been fully considered but they are not persuasive.

As per claim 1, the applicant argues that there is no disclosure in Vig that the probed entity is "intellectual capital", since the thing being measured in claim 1 of the present invention is the intellectual capital of an enterprise. First, it is the combination of Vig and Sanders that disclose the measurement of intellectual capital. Furthermore, Vig discloses that the probed entity, which is measured, can be represented by any known or imaginable entity as shown in Vig, Col. 84, lines 12, and intellectual capital does fall into the any known or imaginable entity group. Therefore, the probed entity of Vig represents the "intellectual capital" of the present invention. In addition, Vig discloses that a societal dollar value of the probed target unit is derived for human

factors such as a human being's opinion as shown in claim 18 of Vig. In claim 18 of Vig, Vig discloses that "current societal dollar value or tanking of said probed target unit...being able accurately to reflect and express the entire range of a human being's opinions, inclinations..."

The applicant also discloses that Vig also fails to teach the following as amended, "selecting a set of metrics that are present within the identified intellectual capitals, the set of metrics comprising one or more metrics present within the human capital, one or more metrics within the structural capital, and one or more metrics within the external capital, wherein the set of metrics comprises one or more monetary metrics and one or more non-monetary metrics. However, Vig discloses this limitation in Col. 73, lines 49-54, by disclosing metrics that are represented by the characteristics, quality, trait, etc., and are relevant to the probed entity group, and where the probed entity group is unlimited as to such entity group's nature or constitution. Because of this, these metrics are therefore not limited to only human capital, but also structural capital and external capital as well.

The applicant also argues that Sanders fails to disclose that each intellectual capital comprising "structural capital comprising experience and expertise of the enterprise embedded in one or more processes, policies, and systems associated with the enterprise", or "external capital comprising a value of one or more business relationships of the enterprise with one or more entities" as recited in claim 1, and as amended. However, Sanders discloses organizational structure in Col. 20, lines 35-37, where information about human resources includes information about an individual's

position in the organization al structure. Sanders also discloses external capital comprising a value of one or more business relationships of the enterprise with one or more entities in Col. 20, line 66-Col. 21, line 2. Here, Sanders discloses externalities related to the specific product or service market of the enterprise.

The applicant argues that the proposed combination of Vig and Sanders in Inadequate and Inappropriate, and that there is no motivation to combine the two references. However, the combination of these two references is valid since both references disclose systems for determining the value of an entity, such as an enterprise (as disclosed in Sanders), by receiving feedback from users through surveys.

Claims 5-10, 20, 22-30, 35-40, 49, and 51-59 are dependent on claims 1 and 31 and are rejected for the same reasons as given for claims 1 and 31.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 3623

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Akiba K Robinson-Boyce whose telephone number is 703-305-1340. The examiner can normally be reached on Monday-Friday 8:30 am-5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 703-305-9643. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3988 for regular communications and 703-305-3988 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

A. R.B.
September 27, 2004


TARIQ R. HAFIZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600